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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,801	12/20/2000	Kyoko Kimpara	016891/0831	4022

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EXAMINER

PIERRE, MYRIAM

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/739,801	Applicant(s) KIMPARA ET AL.	
	Examiner Myriam Pierre	Art Unit 2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1, 4, 7, and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, and 11 respectively, of copending Application No.09/734,195. Although the conflicting claims are not identical, they are not patentably distinct from each other because they perform similar functions in an apparatus for translating documents, a method for translating documents, a storage medium recording program enabling a computer to execute similar processes, and a program embodied in electrical signals enabling a computer to execute processes.

As to claims 1,4,7, and 11, the difference in claims 1, 4, 7, and 11, respectively, of the copending application is the information unit having portion

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containing any word or phrase to said server apparatus, instead of "the locational information of any other document".

It would be obvious to one of ordinary skill in the art at the time of invention to use words or phrases to be delivered to server apparatus from a locational information document, locational documents would have words or phrases in the document.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Murata et al (5,987,402).

As to claims 1 and 4, Murata et al. teach an apparatus and incorporating a method for:

translating documents (**a translation module, machine translation system, col. 5, line 5**);

acquiring from a server apparatus a document prepared in a first language (**personal computer from which the user can use a browser to gain access to linked documents, col. 4, lines 34-36**).

separating the document acquired by said data acquisition into a translation-needing portion and a non-translation portion (**translation module able to separate non-textual tags from text, and transferring these tags without modification, col. 5, lines 5-10**);

translating the translation-needing portion obtained by said information separating unit into a second language (**translation module translates the source document, col. 7, lines 28-33**);

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converting the non-translation-needed portion obtained by said information separating unit, where the portion contains information indicating that any word or phrase is to be delivered to said server apparatus, into a version of the portion appended with translating instruction information for recognizing the need to translate the word or phrase entered in said second language into said first language **(recognizing non-textual information, such as tags specifying links to other documents transferring such non-textual information, and a check is done where the language can be identified by searching the document for and character codes characteristic of particular languages and looking up words in a dictionary that for various languages, col. 5, lines 5-11 and col. 7, lines 11-15); and**

synthesizing unit for synthesizing the result of translation by said translation unit and that of the conversion by said information conversion unit and supplying the result of the synthesis to a terminal apparatus, **(displays translated documents, col. 1, lines 66-67).**

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As to claims 2 and 5, Murata et al. teach:

delivering said word or phrase to said server apparatus is the locational information of said server apparatus, and said information conversion unit adds said translating instruction information to this locational information **(language can be identified by words in the document in dictionaries for different languages and tags are added to words or items and tags specify links to other documents, transferring these to the translated document unmodified, col. 7, lines 11-15 and col. 1 lines 19-20 and col. 4, lines 34-38).**

As to claims 3 and 6, Murata et al. teach:

translating a word or phrase entered in said second language into said first language and delivering the result of translation to a server apparatus identified by said location information **(if a translation is necessary the translation module is activated to translate the source document and source document goes through a check for looking up words in the document in dictionaries for different languages col. 7, lines 28-33 and col. 7, lines 3-14).**

As to claims 7 and 11, Murata et al. teach:

a storage medium recording thereon a program enabling a computer to execute the functionality needed for claim 1 (**personal computer running software, and providing the needed electrical signals to accomplish this col. 4, lines 34-38 and col. 4 lines 50-53, respectively**).

processing to acquire from a server apparatus a document prepared in a first language (**a browser with access to the document servers, col. 4, lines 34-36**).

As to claim 8 and 12, Murata et al. inherently teach storage medium with software to provide functionality of claim 2.

As to claim 9, Murata et al. inherently teach on a storage medium, which provides the functionality by using locational information for claim 3.

As to claim 10, Murata et al. teach:

plurality of storage media in which said program is divided and each divided segment is recorded on one or another of said plurality of storage media (**the control module and translation module comprises suitable software running on different computing systems, col. 4, lines 50-52**).

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As to claim 13, Murata et al. teach:

said program further enabling a computer to execute the processing to translate a word or phrase entered in said second language into said first language, and deliver the result of translation to a server apparatus identified by said locational information **(if a translation is necessary the translation module is activated to translate the source document, which has words in the document in dictionaries for different languages, and tags specify links to other documents, transferring these to the translated document unmodified col. 7, lines 28-33 and col. 7 lines 10-14 and co. 5, lines 9-12).**

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure Merrill et al. (AIGDOC'92), Spragins (SIGDOC' 92), Kumano et al. (6,047,252), Warburton (AICCD), Kugimiya et al. (5,005,127), Grefenstette (6,393,951) and Chong (5,175,685).

Merrill et al. teach a framework for making translations to online material.

Spragins teaches developing a hypertext document intended for an international audience.

Kumano et al. teach a machine translation system that divides the incoming text into smaller translatable segments.

Warburton (AICCD) teach translation of terms and software for international use.

Kugimiya et al. teach a system that automatically translates a portion of the input.

Chong teach machine translation scan text server translation, handles words.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myriam Pierre whose telephone number is 703-605-1196. The examiner can normally be reached on Monday – Friday from 5:30 a.m. - 2:00p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Talivaldis Smits can be reached on 703-306-3011. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information As to the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MP

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RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER